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EXAMINER
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NGUYEN, TRAN N

ART UNIT	PAPER NUMBER
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3626

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/734,400	<b>Applicant(s)</b> HECKLE, MARY ARCHULETA	
	<b>Examiner</b> Tran Nguyen	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Notice to Applicant***

This communication is in response to the communication filed 06/27/2008.

Pending claim(s): 1-15, 19. Amended claim(s): 1-3, 8-13, 19. Non-elected claim(s): 16-18.

***Response to Amendment***

As per the rejection of claims 9-12 under 35 USC 112, second paragraph imposed in the previous Office Action, this rejection is hereby withdrawn in view of Applicant's amendment to claims –12.

As per the rejection of claims 1-8 under 35 USC 101 imposed in the previous Office Action, this rejection is hereby maintained in view of Applicant's failure to adequately traverse this rejection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 19 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "said physical document". There is insufficient antecedent basis for this limitation in the claim.

In particular, claim 19 does not previously recite a "physical document".

For purposes of applying prior art, Examiner interprets all instances of "document" in claim 19 to be "physical document".

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, this claim recites "a computer implemented system" comprising "a document processor", "a sorting processor", and "an output processor".

First, while Examiner recognizes that the recited system is capable of processing a "document", Applicant defines "a document" to be "an electronic collection of related data elements" (page 2 paragraph 7).

Second, the recitation "computer implemented" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are

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able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Third, Applicant further defines “a processor” to be “a set of machine-readable instructions for performing a task. A processor comprises any one of.... software” (page 3 paragraph 14).

When read in light of the specification and the level of ordinary skill in the art, Examiner submits that claim 1 is directed towards software *per se*, and is therefore nonstatutory. See MPEP 2106.01(I).

Examiner appreciates that the scope of claim 1 may also envelop hardware embodiments; however, claim 1 also envelops software *per se* embodiments for the reasons above, and is therefore nonstatutory.

All claims dependent thereon, namely claims 2-8, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

Additional clarification is requested.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1-2, 5-8 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (5664109).

As per claim 1, Johnson teaches a system (column 1 line 9) capable of:

(a) being implemented by a computer (Figure 1);

(b) processing data (column 1 line 8) representing medical record documents (Abstract), wherein the medical record documents are generated by health care providers grouped as a network (reads on "a healthcare organization") (column 1 line 30-39) in treating patients (reads on "a patient encounter") (column 1 line 12-28);

the system comprising:

(a) hardware and software (reads on "a document processor") (Figure 1) capable of:

(i) receiving a patient medical record document (reads on "a document representing a record associated with a patient encounter with a healthcare organization") (Figure 2 label 208);

(ii) assigning tags (reads on "appending identifiers to the received document by automatically adding identifiers to said received document to provide a processed document") to identified elements (Figure 4 label 414);

(iii) determining that the document type cannot be identified or document identifiers cannot be extracted (reads on "in response to examining said received

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document to determine whether an identifier in said received document is at least one of, missing and unusable") (column 9 line 33-37);

(iv) linking documents related to the same episode of care (reads on "said patient encounter comprising an interaction of a patient with a healthcare organization including a patient visit") (column 13 line 65 to column 14 line 1);

(v) wherein the identified elements comprise:

(a) type and source of document (reads on "an encounter identifier") (column 9 line 15-37) capable of being used to link documents related to the same episode of care (column 13 line 65 to column 14 line 1);

(b) a patient medical record number (column 9 line 38-65);

(c) sections of a document (reads on "a patient record section identifier") (column 10 line 1-20);

(b) hardware and software (reads on "a sorting processor") capable of extracting values from the document and assigning tags to data elements of the documents (Figure 4 label 412, 414) and linking the documents to the appropriate patient and health care provider (Figure 6 label 622) (reads on "sorting said processed documents based on identifiers appended to said processed document to provide a sorted processed document");

(c) hardware and software (reads on "an output processor") (Figure 1) capable of storing the document and tags in a database (reads on "memory") (Figure 2 label 216) for output to an application (Figure 2 label 220).

As per the set of claim(s): 2, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, respectively, and incorporated herein.

In particular, Johnson teaches identifying a unique match of the patient identifier, (Figure 6 label 610) and comparing the patient's most current demographic data to that contained in the document (Figure 6 label 624). According to Johnson, significant differences indicate possible update to patient demographics (Figure 6 label 628).

As per claim 5, Johnson teaches interactive extraction of the tags discussed in the rejection of claim 1 above (reads on "user selection and entry") (Figure 4 label 410).

As per claim 6, Johnson teaches processing documents in response to:

- (a) an admission form (column 9 line 18);
- (d) a discharge summary (column 9 line 26).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of "at least one of".

As per claim 7, Johnson teaches software and hardware (reads on "an identification processor") capable of extraction processing (Figure 2 label 212, 214).

As per claim 8, Johnson teaches that the system is capable of assigning tags after identifying the source and type of document (Figure 4 label 414).



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 3-4, 9-15, 19 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson.

As per claim 3, Johnson teaches receiving a hardcopy (column 6 line 44-55). Johnson further teaches converting the hardcopy to electronic format (column 6 line 45-55), and is processed as discussed in the rejection of claim 1 above, and incorporated herein.

Johnson does not teach “imprinting said identifiers onto said [paper] documents”.

Johnson further teaches that the processed electronic medical record document may be printed and sent by physical mail or fax (column 15 line 15-19). Johnson further

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teaches displaying a digital image of the document (column 15 line 10-11). Johnson further teaches that the server is capable of reviewing the tags associated with a document before presenting the document for display (column 15 line 33-37).

Because Johnson teaches systems for processing electronic and hardcopy documents, it would have been obvious to one of ordinary skill in the art to substitute electronic for paper documents to achieve the predictable results of providing processed patient medical records.

As per claim 4, Johnson teaches using ASCII characters to identify the tags discussed above in claim 1 (reads on “characters” and “other codes”) (Figure 9).

As per the set of claim(s): 9, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 3, respectively, and incorporated herein.

As per claims 10-12, Johnson teaches querying patient records based on a plurality of identifiers, including complex queries comprising fielded queries (column 15 line 19-37).

As per claim 13, this claim is rejected for the same rationale as cumulatively applied to claims 1, 9 above, and incorporated herein.

As per claim 14, this claim is rejected for the same rationale as cumulatively applied to claims 10-12 above, and incorporated herein.

As per claim 15, Johnson teaches storing information to access and use of the system by subscribers for security purposes (column 14 line 4-25).

As per the set of claim(s): 19, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 3, respectively, and incorporated herein.

### ***Response to Arguments***

Applicant's arguments filed 06/27/2008 have been fully considered but they are not persuasive.

As per claim 1, on page 9 Applicant argues that this claim is directed to statutory subject matter.

First, the specification discloses (page 3):

[14] **processor** - a device and/or set of machine-readable instructions for performing a task. A processor comprises any one or combination of hardware, firmware, and/or software. A processor acts upon information by manipulating, analyzing, modifying, converting, transmitting the

Based on the ordinary rules of logic and grammar of the English language, the highlighted portion can be rewritten to be the following:

"A processor comprises any one of:

- (a) hardware *per se*;
- (b) firmware *per se*;
- (c) software *per se*;
- (d) hardware and firmware;
- (e) hardware and software;
- (f) firmware and software; or
- (g) hardware, software, and firmware."

As the result, Examiner submits that software *per se* embodiments (c) are enveloped by "processor".

To clarify, Examiner is not taking the position that the definition of "processor" encompasses only software *per se*. As stated on page 5 in the previous Office Action and above, Examiner acknowledges that "processor" can also envelop hardware embodiments.

Nevertheless, software *per se* embodiments, see embodiment (c) above, are also enveloped by Applicant's definition of "processor".

Additionally, Applicant asserts that "a document processor", "a sorting processor", and "an output processor" are hardware elements.

As also stated in page 5 of the previous Office Action and above, the specification discloses (page 2):

**[7] document - a physical and/or electronic collection of related data elements. If physical, a document comprises one or more sheets of paper and the related data elements printed thereon. A document can be and/or represent a record of a patient encounter with a healthcare organization.**

Based on Applicant's definition, a document can be:

- (1) a physical collection of related data elements; or
- (2) an electronic collection of related data elements.

While Examiner acknowledges that "a document processor", "a sorting processor", and "an output processor" can be hardware elements when processing embodiment (1) above, Examiner submits that these limitations recite software *per se* embodiments when processing embodiment (2) above.

Therefore, Examiner submits that embodiments (b) and (2) as defined by Applicant are directed towards nonstatutory subject matter.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., document processor 1700 comprises a copier for providing physical copies of provided paper documents, a scanner for obtaining an electronic document version of a paper document, and a printer for printing a paper copy of a document and/or record including the identifiers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner submits that had these limitations been claimed, claim 1 would therefore be limited to a system capable of processing physical documents, and would therefore be statutory under 35 USC 101 similar to claims 9-15.

Applicant is invited to contact Examiner for suggestions on how to overcome this rejection.

On page 9 Applicant further argues that “a computer implemented system” renders the claim statutory.

In response to applicant's arguments, the recitation “a computer implemented system” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant is invited to contact Examiner for suggestions on how to breathe life and vitality into the preamble.

On page 10-11 Applicant argues that the applied art “teaches away from the claimed system”.

“Arguments that the alleged anticipatory prior art... teaches away from the invention’... [are] not germane’ to a rejection under section 102.” *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). MPEP 2131.05.

On page 11 Applicant further argues that the applied art do not teach ““automatically adding identifiers to said received documents... said identifiers including... a medical record identifier” that are sorted “based on identifiers appended” to the document”.

In making this argument, on page 10 Applicant asserts:

**As Johnson explicitly states, “[u]nique subject identifiers are not preassigned by the central record keeping system or used for linking” (Johnson col. 2 lines 20 – 22). Instead, Johnson relies on demographic data to determine when different documents should be associated with the same individual.**

Applicant’s characterization is inaccurate and incomplete. Johnson is clearly directed at a centralized patient record repository, wherein a plurality of health care providers are able to share patient records without having to adopt a standardized patient identifier (column 1 line 51 to column 2 line 10).

According to Johnson, each provider can use their own respective patient identifiers without having to resort to a single standardized patient identifier. The system of Johnson is able to link all different patient identifiers into a Master Patient Identifier (MPI) for each patient (Figure 6 label 632), and also acknowledged by Applicant on page 11.

Accordingly, Johnson teaches identifying data elements in the document (Figure 4 label 412, 414) and linking the document to the patient's unique MPI (Figure 6 label 622).

Therefore, the applied art anticipates the claimed invention.

On page 11 Applicant further argues that the applied art do not teach "in response to examining said received document to determine whether an identifier is at least one of, missing and unusable,... and... sorting said processed document based on identifiers appended to said processed document".

Johnson teaches determining that the document type cannot be identified or document identifiers cannot be extracted (reads on "in response to examining said received document to determine whether an identifier in said received document is at least one of, missing and unusable") (column 9 line 33-37).

Johnson further teaches linking the documents to the appropriate patient and health care provider (Figure 6 label 622) (reads on "sorting said processed documents based on identifiers appended to said processed document to provide a sorted processed document").

Therefore, the applied art anticipates the claimed invention.

On page 11 Applicant asserts "Johnson describes, in its MPI Populator process, relying on demographic data to attempt to identify an individual patient, and linking



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documents to a Master Patient Index after ascertaining which patient a particular document concerns (Johnson col. 13 lines 1-16)".

Applicant's characterization is inaccurate and incomplete.

Johnson teaches (column 11);

**Beginning at step 608, the MPI Populator process attempts to link the document to a specific patient. First, it searches for a matching medical record number in the lists 45 of medical record numbers by facility or source maintained for each patient in the MPI database. A unique match must be found, meaning that no other patient identifier has the same medical record number from that facility or source. If, at decision step 610, there is no unique match, the process 50 then begins comparing other extracted patient demographic information to that stored in the MPI database.**

According to Johnson, unique patient identifier matches are first determined.

Johnson only relies on extracted patient demographic information if no unique match is found.

Examiner submits that adding the document based on extracted data elements and linking the document to a patient reads on "a sorting processor for sorting said processed document based on identifiers appended to said processed document".

On page 11 Applicant further argues that the applied art "does not append identifiers to a document".

In making this argument, Applicant admits (page 11):

**Instead, Johnson extracts information from a document to build a database record. In Johnson, the original document (in scanned form) is stored unchanged (Johnson col. 7 lines 22 – 23). A rules-based method then attempts to extract information from the scanned file and build a new set of database entries based on the extracted information (Johnson col. 7 lines 31 – 57).**

Applicant provides no definition for “append”.

In determining the scope of the claim, Examiner relies on Microsoft Computer Dictionary, Fifth Edition, which defines “append” as “To place or insert as an attachment by adding data to the end of a file or database or extending a character string”.

As admitted by Applicant, Johnson builds new sets of database entries representing metadata of the document.

Based on the definition afforded by Microsoft Computer Dictionary, Fifth Edition, Examiner submits that adding data, and especially metadata descriptive of a document, to a database to be “append”.

On page 11 Applicant further asserts the advantage of “creation of a valid audit trail that includes the formerly unavailable information”.

Examiner submits that the system of Johnson is capable of providing auditing functions, including providing metadata descriptive of the document (Figure 6 label 622) and alerting a user of errors (Figure 6 label 620).

Therefore, the asserted advantage does not distinguish the claimed invention from the prior art.

Examiner notes that the particular auditing features asserted by Applicant is not evident by the claim, and appears to be a latent property of the data identifiers.

On page 11 Applicant further argues that the applied art do not teach using the original physical documents.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., physical documents) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In particular, Applicant's definition of "document" includes both hardware and software embodiments, as discussed above and incorporated herein.

The remainder of Applicant's arguments on page 11-12 merely rehash arguments previously addressed above, and incorporated herein.

On page 12 Applicant further argues that the applied art do not teach "an identifier "identifying a particular healthcare encounter of a particular patient"".

The specification discloses (page 2):

- [6] **patient encounter** - a patient and healthcare organization interaction that has a financial or transaction consequence. A patient encounter can include any of several types of events, for example, a patient visit, phone call, inpatient stay, outpatient treatment, interview, examination, procedure, treatment-related occurrence, admission to a healthcare organization, test, order for medication, discharge, and/or a user-defined event based on acquired information, etc. A patient encounter can be bounded by a start and/or end time (and/or date), which can be determined by time and/or date of the event, for example, a time and/or date of patient admission and/or discharge from a healthcare organization.

Johnson teaches linking documents related to the same episode of care (column 13 line 65 to column 14 line 1).

Examiner submits the following references from class 705, subclass 3: Lockwood (5706441), Cave (5970463), Whiting-O'Keefe (6061657), Seare (6223164), Aghili (6289316), Dang (6370511). Numerous other references exist in the prior art.

Based on the existing knowledge in the prior art, an episode of care is an arbitrary representation of a patient encounter, wherein a plurality of services may be related to a specific episode of care to signify the total care delivered to a patient for a specific episode, i.e. a disease, a period of time, each time the patient seeks medical care, etc.

Based on the evidence presented above, Examiner submits that linking patient records to a specific episode of care reads on “an identifier “identifying a particular healthcare encounter of a particular patient””.

As per claim 2, on page 12 Applicant argues that the applied art do not teach “wherein an unusable identifier is at least one of incorrect, conflicting and illegible”.

Johnson teaches identifying a unique match of the patient identifier, (Figure 6 label 610) and comparing the patient’s most current demographic data to that contained in the document (Figure 6 label 624). According to Johnson, significant differences indicate possible update to patient demographics (Figure 6 label 628).

Examiner submits that patient demographic data is considered to be “an identifier”, wherein conflicting demographic data signifies “incorrect” or “conflicting” identifiers”.

The remainder of Applicant’s arguments on page 12 merely rehash arguments previously addressed above, and incorporated herein.

As per claim 3, on page 13-14 Applicant asserts:

**Claim 3 is further considered patentable because, as the Office Action concedes, Johnson neither discloses nor suggests wherein “said received document is a paper document comprising data representing a patient medical record associated with a patient encounter with a healthcare organization and said document processor appends said identifiers to said received document by imprinting said identifiers onto said document” as recited in claim 3.**

Examiner submits that this characterization of the Office Action is inaccurate. See page 9 of the previous Office Action.

As later acknowledged by Applicant on page 14, initial paper processing is known. The only difference between the claimed invention and Johnson is “imprinting said identifiers onto said document”, wherein the imprinted document is paper.

On page 14 Applicant further argues that the applied art do not teach paper processing to the extent recited by claim 3.

Examiner submits that all processing recited by Applicant is taught by Johnson. Johnson further teaches that the system is capable of providing all documents and all tags associated thereto (column 15 line 33-37).

Additionally, the system of Johnson is capable of printing hard copies of the medical records (column 15 line 15-19).

Examiner submits that at the time the invention was made, it would have been obvious to substitute electronic processing for paper processing to obtain the same predictable result of providing data to the end user.

Additionally, Examiner further submits the same IFW system used by Applicant to process this application as an indicium of the predictability and the level of ordinary skill in the art to substitute digital image processing in lieu of paper files.

On page 14 Applicant argues that there is no motivation to “extend the system of Johnson to handle damaged or incomplete documents”.

Examiner submits that *KSR International Co. v. Teleflex Inc.*, 550 U.S.--, 82 USPQ2d 1385 (2007) forecloses the argument that a specific teaching, suggestion, or

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motivation is required to support a finding of obviousness. See also *Ex parte Smith*, -- USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396). See MPEP 2143.

Additionally, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Interf. 1985).

In particular, the only difference between the claimed invention and the prior art is the imprinting onto paper documents. The rationale to arrive at the claimed invention has been provided above, and incorporated herein.

The remainder of Applicant's arguments on page 14-16 merely rehash arguments previously addressed above, and incorporated herein.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Applicant is advised to review the disclosure of Aghili in its entirety.

The new ground(s) of rejection presented in this Office action, if any, was/were necessitated by Applicant's amendment. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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/T. N./

Examiner, Art Unit 3626

08/16/2008

/C Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626